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Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1985

ANDREW F. EHAT,

Petitioner,

v.

JERALD TANNER and SANDRA TANNER,
dba MODERN MICROFILM COMPANY,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

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QUESTIONS PRESENTED

1. Whether the ruling of the Tenth Circuit Court is contrary to the recent holding of this court in the case of Harper & Row v. Nation Enterprises, 471 U.S...85 L.Ed. 2d 588, 105 S.Ct...

2. Whether Harper & Row applies to historical research not otherwise copyrightable.

3. Whether the new copyright act of 1976 pre-empts that body of law pre-existing under the general heading of "unfair competition" beginning with International News Service v. The Associated Press, 248 U.S. 215 (1918), 63 L.Ed. 211, 39 S.Ct. 68, and continuing through Roy Export Company Establishment v. Columbia Broadcasting System, Inc., 672 F.2d 1095 (2nd Circuit)(1982).

4. Whether the decision of the Tenth Circuit Court ignores the Congressional Intent in enacting the Coypright Act of 1976, more specifically Section 301(b)(3) and the explanatory notes related thereto.

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Petitioner, Andrew F. Ehat, prays that a writ of certiorari issue to review the

Judgment and opinion of the United States Court of Appeals for the Tenth Circuit entered in the above-entitled case on December 30, 1985, overuling the decision of the United States District Court for the Central Division of Utah.

CITATIONS TO THE RECORD AND OPINIONS BELOW

The opinion of the Court of Appeals was reported at 780 F.2d 876 and is reproduced at Appendix A hereto. The District Court's Findings of Fact, Conclusions of Law and Judgment are reproduced at Appendix B hereto.

JURISDICTION

The Court of Appeals entered its Judgment (Appendix A) on December 30, 1985, and denied a timely petition for rehearing and petition for rehearing en banc on February 10, 1986. The jurisdiction of the court is invoked under 28 USC, paragraph 1254(1)(1970).

STATUTES INVOLVED

The statutes involved are United States Code, Title 17, paragraphs 301(a) and 301(b), which provide in pertinent parts:

(a) "On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by Section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by Sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any state."

(b) "Nothing in this title annuls or limits any right or remedies under the common law or statutes of any state with respect to:

(3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by Section 106."

STATEMENT OF THE CASE

The opinion of the Tenth Circuit succinctly states the relevant facts.

"Ehat was a scholar engaged in post-graduate research on the history of the Church of Jesus Christ of Latter-Day Saints (the LDS Church). The Tanners publish and distribute documents and works relevant to the LDS Church. In the course of his research, Ehat examined and took

> notes from a 350-page transcript of the William Clayton Journals at the LDS Church Archives. Ehat gave to his colleague, Lyndon Cook, material consisting of quotations he and another researcher had taken from the Journals as well as his own notes and comments. This material was surreptitiously taken from Cook's office, copied, and replaced. One of these unauthorized copies found its way to the Tanners, who had no part in the original removal from Cook's office. They blacked out the material added by Ehat, printed the original extracts, and sold them to the public.
>
> Ehat's complaint asserted claims under the federal copyright statutes, on which the judge granted summary judgment for the Tanners. In addition, the complaint alleged state common law claims for unfair competition and unjust enrichment. Following a bench trial on these claims, the Court entered judgment for Ehat. On appeal, the Tanners assert that the district court erred in awarding damages on Ehat's common law claims because those claims are preempted by the federal copyright statutes. (Appendix A, page A-3 to A-5)

The Tenth Circuit's language that the 77 pages of notes belonging to Petitioner "were surreptitiously taken" is a euphamism for stolen. Moreover, the Trial Court found that the Respondents well knew that they were stolen when a copy of the notes reached their

establishment, that they indeed exulted in the fact that they were now printing stolen documents. So the fundamental issue presented on this appeal is whether the Tenth Circuit Court opinion should be allowed to stand thus permitting theives and receivers of stolen documents full impunity to ply their trade.

REASONS FOR GRANTING THE WRIT

POINT I.

The Tenth Circuit Court opinion is contrary to this Court's decision in Harper & Row.

The Trial Court in making his Findings of Fact expressly held that in the blacking out process the defendants removed from the notes any indicia of "authorship" that would give the works the resulting copyrightability.

In his Findings, Judge Christensen specifically found:

> "that plaintiff had acquired and had a special possessory interest in his notes as he had personally prepared them, which was recognized by the limited number of colleagues with which he shared copies and particularly by Lyndon W. Cook. That special proprietary or

property interest in his physical notes did not include any copyrightable interest in their content apart from certain interpretations and comments hereinafter to be mentioned.

The Trial Court continued:

> "The quotations from the Clayton journals themselves were not a product of any literary effort of accomplishment by plaintiff nor any creativity and were not subject to copyright or any copyright interest in plaintiff's favor, but plaintiff's right in the Ehat notes as a physical matter and property was of a nature and character different in kind from any copyrightable interest that may have existed in said original writings comprising the Clayton journals, and were and are not within the scope or purpose of right established under the copyright laws of the United States or any equivalent." (Emphasis added)(Appendix B, page 10-11).

The opinion of the Circuit Court not only ignores those express Findings of the Trial Court but says categorically, "Literary works, including compilations and derivative works, are within the subject matter of copyright if they are original works of authorship fixed in any tangible medium of expression. See 17 U.S.C. paragraph 102, 103. This is so

notwithstanding the material could not be copyrighted. See Harper & Row, 723 F.2d. at 200. The material at issue here clearly falls within the subject matter of copyright. The District Court did not address this issue, and Ehat does not argue otherwise on appeal." (Appendix A, page A-8)(Emphasis added). There is not a whisper in the Circuit Court opinion to suggest that the notes stolen and printed herein were "original works of authorship fixed in any tangible medium of expression." Moreover petitioner and the Trial Court did "address the issue" as noted above.

There is thereafter no statement in the Circuit Court opinion nor any reference to the transcript to show that the notes, verbatim extracts from William Clayton's journals, come "within the subject matter of copyright." The Circuit Court's opinion simply makes a blanket assertion both of law and fact with no reference whatever to the record and in direct conflict with the explicit findings of the

Trial Court. The Circuit Court cannot reverse the Trial court's Findings on legal issues and should not on equitable issues unless the record on appeal shows the clear weight of the evidence demands.

The Harper & Row citation, noted above, is to the Second Circuit opinion reversed by this Court, which reversal happened after the oral argument of the case at bar before the Tenth Circuit but before the opinion was rendered. Copies of this Court's decision in Harper & Row were furnished by the undersigned to the members of the Tenth Circuit Court before the written decision was issued.

Circuit Judge Seymour's opinion, speaking for the Tenth Circuit, continues:

> "In an effort to distinguish this case from a pre-empted claim, the District Court granted Ehat relief based on its finding that, by printing and selling Ehat's notes, the Tanners `bodily appropriated the work product of plaintiff' and derived a profit from their misappropriation [Citation to Record]. We need not decide whether this misappropriation of material states a claim for relief under Utah law. Assuming that is does, [cases and commentary cited], we see no

> distinction except between such a state right and those exclusive rights encompassed by federal copyright laws. [Cases cited]. We cannot agree with the District Court that Ehat's state claim was not within the scope of copyright because it was based on his right in the notes 'as a physical matter and property.' [Citation to Record]. Ehat did not allege a state law claim of conversion to recover for the physical deprivation of his notes. Instead he sought to recover for damage flowing from their reproduction and distribution. [Citation to the Second Circuit Harper & Row opinion]. Such reproduction interferes with an intangible, literary or artistic property right equivalent to copyright. [Treatise quoted]." (Emphasis Added)(Appendix A, page A-10).

So the Tenth Circuit Court says that the petitioner had only a physical right to possession of the actual paper on which his notes were made with no other property rights in the notes that would fall outside the scope of copyright. That flies directly in the face of the expressed language of this Court in Harper & Row and while the Trial Court did not coin the phrase "the right of first publication, an important, marketable, subsidiary right" Justice O'Connor, speaking

for the majority of this Court makes it very clear that such a right does indeed exist and is independent of the physical paper requiring an action for conversion to retrieve.

Indeed, referring to that opinion of this Court, Judge Seymour in the Tenth Circuit states that Harper & Row "was reversed on other grounds." (Appendix A, page A-7). The undersigned respectfully submits that the Harper & Row case was not reversed on "other grounds" but rather, the ground for reversal included the very grounds employed by the Trial Court in the case at bar.

While it is true that in Harper & Row the question of fair use and certain other doctrines were involved, the opinion of the Supreme Court makes it clear that it reversed the Second Circuit on all points. The very opinion itself which awarded relief to plaintiff for violation of their pre-publication rights indicates that it has approved in this substantial area a right not preempted by the new copyright law. It

therefore seems inconsistent for the Tenth Circuit Court to cite the Second Circuit's decision in Harper & Row's language of preemption when this Court's decision which reverses it, reaffirms a substantial area of non-preemption. We believe that the opinion of the Supreme Court in Harper & Row makes it clear that an author, even a compiler has a "first right of publication" in both copyrightable and uncopyrightable material which is a valuable property right and which cannot be infringed upon even when dealing with historical or factual as opposed to creative matters.

It should be noted at this point that whereas, in Harper & Row, the Nation Magazine scooped Time by publishing an article largely created with indicia of authorship and using some three to four hundred words of the Gerald Ford manuscript, in the case at bar the respondent appropriated petitioner's entire 77 pages of notes and printed them in full. So we are not dealing here with just 13% of a

creative article as in Harper & Row, even though that percentage was "the heart" of the Ford manuscript, here we are dealing with the whole heart and soul, the complete set of notes.

POINT II.

The rationale of this Court's decision in Harper & Row applies equally to uncopyrightable, unpublished research as it does to works of authorship.

In Justice O'Connor's opinion, speaking for the majority, she said:

> "In its commercial guise, however, an author's right to choose when he will publish is no less deserving of protection. The period encompassing the work's initiation, its preparation, and its grooming for public dissemination is a crucial one for any literary endeavor. The Copyright Act, which accords the copyright owner the `right to control the first public distribution' of his work, House Report, at 62, echoes the common law's concern that the author or copyright owner retain control throughout this critical stage. See generally Comment, The Stage of Publication as a "Fair use" Factor: Harper & Row, Publishers v. Nation Enterprises, 58 St. John's L Rev 597 (1984). The obvious benefit to author and public alike of assuring

authors the leisure to develop their ideas free from fear of expropriation outweights any short term "news value" to be gained from premature publication of the author's expression. See Goldstein, Copyright and the First Amendment, 70 Colum L. Rev 983, 1004-1006 (1970) (The absolute protection the common law accorded to soon-to-be published works "[was] justified by [its] brevity and expedience"). The author's control of first public distribution implicates not only his personal interest in creative control but his property interest in exploitation of prepublication rights, which are valuable in themselves and serve as a valuable adjunct to publicity and marketing. See Belushi v. Woodward, 598 F Supp 36 (DC 1984)(successful marketing depends on coordination of serialization and release to public); Marks, Subsidiary Right and Permissions, in What Happens in Book Publishing 230) (C. Grannis ed 1967)(exploitation of subsidiary rights is necessary to financial success of new books). Under ordinary circumstances, the author's right to control the first public appearance of his undisseminated expression will outweigh a claim of fair use." (Emphasis added)(85 L.Ed. 2d 603, 604).

Continuing, the opinion reads:

"Where an author and publisher have invested extensive resources in creating an original work and are poised to release it to the public, no legitimate aim is served by preempting the right of first publication. The fact that the

words the author has chosen to clothe his narrative may of themselves be "newsworthy" is not an independent justification for unauthorized copying of the author's expression prior to publication. To paraphrase another recent Second Circuit decision:

"[Respondent] possessed an unfettered right to use any factual information revealed in [the memoirs] for the purpose of enlightening its audience, but it can claim no need to `bodily appropriate' [Mr. Ford's] `expression' of that information by utilizing portions of the actual [manuscript]. The public interest in the free flow of information is assured by the law's refusal to recognize a valid copyright in facts. The fair use doctrine is not a license for corporate theft, empowering a court to ignore a copyright whenever it determines the underlying work contains material of possible public importance." Iowa State University Reserach Foundation, Inc. v. American Broadcasting Cos., Inc. 621 F2d 57, 61 (1980)(citations omitted)."

Accord, Roy Export Co. Establishment v. Columbia Broadcasting System, Inc. 503 F Supp 1137 (SDNY 1980) ("newsworthiness" of material copied does not justify copying), aff'd 672 F2d 1095 (CA2), cert denied. 459 US 826, 74 L Ed 2d 63, 103 S Ct 60 (1982)" (Emphasis added) (85 L.Ed 2d 605).

It is submitted that whereas the researcher in the uncopyrightable arena of

historical facts by the very process of taking notes and selecting that which he ultimately intends to use is investing "extensive resources" which may well be part of an original and later copyrightable work. To leave that unpublished research in a no-man's land of easy prey to document pirates puts all historians doing research and others in related social and physical science research fields dealing with collection of facts (as well as the repositories where those facts, unpublished journals, case histories, data banks, etc., repose), in jeapordy. Moreover it acts as a serious deterrent to research because it puts the researcher at risk until he publishes; surrounding the research with his original, creative authorship. That jeapordy is not essentially different, the undersigned submits, from the jeapordy in which ex-President Ford was put, between the time of creation of his manuscript and the publication of extracts therefrom by the Nation magazine. The researcher's notes in

this instance are simply one step before the creative process that existed in the Harper & Row situation and that one critical step is the difference between copyrightability with attendant protection and uncopyrightability and no protection if the Tenth Circuit Court's opinion is allowed to stand.

Such a distinction would work against, not for the free dissemination of ideas. Moreover, a researcher's right to choose when he will publish is essentially the same right before he has clothed the research with authorship as well as after he has done so, and in either case brings him clearly within the language of Harper & Row cited above. This is because the research is part and parcel of the "period encompassing the works initiation, its preparation, and its grooming for public dissemination." It is indeed the beginning step of that very process.

POINT III.

The Copyright Act of 1976 did not preempt

that body of law known as "the Unfair Competition" cases.

The undersigned quotes again that portion of the Tenth Circuit opinion relating to pre-emption:

> "We need not decide whether this misappropriation of materials states a claim for relief under Utah law. Assuming that is does, see, generally, International News Service v. Associated Press, 248 US 215 (1918), Prosser and Keeton on Torts, paragraph 130 at 1020-22 (5th Ed. 1984), we see no distinction between such a state right and those exclusive rights encompassed by the federal copyright laws. See Warner Brother's Inc. v. American Broadcasting Co.'s., 720 F.2d, 231, 247 (2d Cir 1983)(`state law claims that rely on the misappropriation branch of unfair competition are preempted'); Schuchart and Associates, 540 F.Supp. at 943-44 (same). See, generally, 1 Nimmer, paragraph 1.01[B], at 1-16 to 1-22." (Emphasis added).

Warner Brothers cited above was a Second Circuit decision rendered a year after the Roy Export case, cited with approval in the Supreme Court's Harper & Row decision noted above in Point II. Those three cases, the two cited herein and Roy Export point up the

conflict. Our Tenth Circuit opinion alludes again to the Roy Export Company case, 672 F.2d 1095 in a footnote at the end of the opinion (Appendix A, page A-15) and says reliance on that case is "misplaced because that case is decided under the prior copyright law." As argued hereafter in more detail, the re-enacting of the copyright law did not overule Roy Export and its predecessors under the guise of "preemption." Accordingly, this Court needs to clearly resolve that conflict between the Warner and Schuchart cases and the International News Service to Roy Export body of law and clearly and affirmatively reassert the longstanding law that some recognized types of expression, though not copyrightable are still protected from misappropriation under the Unfair Competition theory, whether they be news (INS) or film clips partly in the public domain (Roy Export) or in historian's unpublished research notes.

POINT IV.

In enacting the 1976 copyright act, Congress did not intend to eliminate the Unfair Competition cases.

The Tenth Circuit opinion in the case at bar quotes Section 301(a) set out at the beginning of this petition which contains the preemption language on which the opinion is based and further quotes the committee of the judiciary notes suggesting congressional intent, (Appendix A, page A-15) but the Court neglects to refer to Sub-section (b) also set out at the beginning of this petition but which is here repeated as follows:

> "(b) Nothing in this title annuls or limits any right or remedies under the common law or statutes of any State with respect to --
>
> (1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or
>
> (2) any cause of action arising from undertakings commenced before January 1, 1978; or
>
> (3) activities violating legal or equitable rights that are not

equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106." (Emphasis added).

The relevant explanatory notes of this section provide:

> "In a general way subsection (b) of section 301 [subsec. (b) of this section] represents the obverse of subsection (a). It sets out in broad terms and without necessarily being exhaustive, some of the principal areas of protection that preemption would not prevent the States from protecting. Its purpose is to make clear, consistent with the 1964 Supreme Court decisions in Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 [84 S.Ct. 784, 11 L.Ed.2d 661 rehearing denied 84 S.Ct. 1131, 376 U.S. 973, 12 L.Ed.2d 87], and Compco Corp. v. Day-Brite Lighting, Inc. 376 U.S. 234 [84 S.Ct. 779, 11 L.Ed.2d 669, rehearing denied 84 S.Ct. 1162, 377 U.S. 913, 12 L.Ed.2d 183], that preemption does not extend to causes of action, or subject matter outside the scope of the revised Federal Copyright statute.

The note continues:

> 'Misappropriation' is not necessarily synonymous with copyright infringement, and thus a cause of action labeled as 'misappropriation' is not preempted if it is fact based neither on a right within the general scope of copyright as specified by section 106 [section 106 of this title] nor of a right equivalent thereto. For example, state law should have the

> flexibility to afford a remedy (under traditional principles of equity) against a consistent pattern of anauthorized appropriation by a competitor of the facts (i.e., not the literary expression) constituting "hot" news, whether in the traditional mold of International News Service v. Associated Press, 248 U.S. 215 (1918)[39 S.Ct. 68, L.Ed. 211], or in the newer form of data updates from scientific, business, or financial data bases. Likewise, a person having no trust or other relationship with the proprietor of a computerized data base should not be immunized from sanctions against electronically or cryptographically breaching the proprietor's security arrangements and accessing the proprietor's data." Report No. 94-1476, House Committee on the Judiciary.

Thus, it is reasonably clear that Congress intended to leave intact the status quo. To the same effect is this Court's holding in Harper & Row in construing Section 107 of the new copyright act as follows:

> "Even if the legislative history were entirely silent, we would be bound to conclude from Congress' characterization of Section 107 as a `restatement' that its effect was to preserve existing law concerning fair use of unpublished works as of other types of protected works and not to `change, narrow, or enlarge it.' Id., at 66. We conclude that the

> unpublished nature of a work is `[a] key, though not necessarily determinative factor' tending to negate a defense of fair use. Senate Report, at 64. See 3 Nimmer Section 13.05, at 13-62 n 2; W. Patry, The Fair Use Privilege in Coypright Law 125 (1985)(hereinafter Patry)." (Emphasis added)(85 L.Ed. 2d 603).

In its preemption argument the Tenth Circuit erred on two counts. One, it ignored Sub-section (3) of Paragraph (b) of Section 301 and second, it disregarded the explanatory notes thereto which make it clear that the new copyright act was intended as a re-enactment or a "restatement" that preserved the existing law and was not intended to "change, narrow or enlarge it."

CONCLUSION

Judge A. Sherman Christensen, the Trial Judge in this case fairly summarized the fundamental issues raised by the facts of this case when ruling from the bench at the conclusion of the trial as follows:

> "I have inquired of myself whether it must be held that our legal system has painted itself and its citizens into a corner where private archives can no longer

honestly acquire, process, study, and publish manuscripts which have not already entered the public domain and exercise over them a proprietary right or permit others to do so in private under limited permission until within that permission they are made a part of the public domain.

But must it be held that where as such documents as studied and analyzed in private they can be physically stolen or equivalently misappropriated and then through this means added to the public domain by peddling them for profit to whomsoever the thief or receiv[er of] the documents with knowledge of the theft may wish, and that thereby the recipients can enrich themselves or accomplish their pecuniary or nonpecuniary purposes, and that the exchange of historical documents must be underground, and that the law must recognize that underground distribution of stolen documents is the -- an accepted way of life beyond protection, and particularly in the context of this case that when that surfaces the law will protect the public exploitation of stolen documents as such, independent of the ideas which they may portray. If this were so, we would hav established a system designed to destroy the very foundations of scholarly research and the preservation of historical writings and the relevant widening public knowledge of history, and every depository from the east coast to the west coast would have to revise its basic principles and be victims without legal remedy to anyone who directly or indirectly

steals their physical property, and with knowledge or with knowledge of theft publishes it contrary to their claimed rights and against their will.

I do not think under the authorities that I have read that the courts have been so painted into a corner of futility and self-defeat of this nature, and if that were so, it would be a step immeasurably back from the spread of knowledge that has occurred within the protection of our constitution and established authority, and particularly with regard to writings. If it were to be held that no property in the physical writing could be protected in a court of law even though that physical writing were stolen unless it were subject to copyright or a right equivalent thereto, not including theft, it would be an unfortunate thing. On the contrary, however, I believe that some of the strongest and most respected pillars of the common law [and] equity and the state rule which I think will be recognized and is recognized in Utah in principle mandate to the contrary, among these are nemo dare potest quod non habet, no man can give what he hasn't got. Thou shalt not steal. He who receives stolen property acts improperly in the same kind although not in the same degree necessarily as the thief. One may not profit by his own wrong. (Appendix B, page 30-33)(Emphasis added).

Judge Christensen therefore fairly and directly addressed the issues of this case and they are vital issues of importance and impact not only to Utah but to historians and researchers throughout the nation.

It is hardly fair to uphold a Tenth Circuit opinion which skirts all the issues by simply saying the whole matter has been pre-empted by the new copyright act.

For the foregoing reasons, Petitioners respectfully request that this Court issue its Writ of Certiorari to the Tenth Circuit Court for review of its opinion.

Respectfully submitted,

GORDON A. MADSEN
ROBERT C. CUMMINGS

APPENDIX A

Andrew F. EHAT, Plaintiff-Appellee,

v.

Jerald TANNER AND Sandra Tanner, dba Modern Microfilm Company, Defendants-Appellants.

No. 84-1787

United States Court of Appeals, Tenth Circuit.

Dec. 30, 1985

Scholar brought action alleging injury from unauthorized reproduction and sale of literary material in which he claimed proprietary interest. The District Court for the District of Utah, A. Sherman Christensen, J., entered judgment against defendants. Defendants appealed. The Court of Appeals, Seymour, Circuit Judge, held that state common-law claims for unfair competition and unjust enrichment were preempted by federal copyright statute.

Reversed and remanded.

Before HOLLOWAY, Chief Judge, SEYMOUR, Circuit Judge, and BALDOCK, District Judge.

SEYMOUR, Circuit Judge.

Andrew Ehat brought this action against Gerald and Sandra Tanner, dba Modern Microfilm Company (the Tanners), alleging injury from the Tanners' unauthorized reproduction and sale of literary material in which Ehat claimed a proprietary interest. Judgment was entered against the Tanners, and they appeal. We reverse.

Ehat was a scholar engaged in post-graduate research on the history of the Church of Jesus Christ of Latter-Days Saints (the LDS Church). The Tanners publish and distribute documents and works relevant to the LDS Church. In the course of his research, Ehat examined and took notes from a 350-page transcript of the William Clayton Journals at

the LDS Church Archives. Ehat gave to his colleague, Lyndon Cook, material consisting of quotations he and another researcher had taken from the Journals as well as his own notes and comments. This material was surreptitiously taken from Cook's office, copied and replaced. One of these unauthorized copies found its way to the Tanners, who had no part in the original removal from Cook's office. They blacked out the material added by Ehat, printed the original extracts, and sold them to the public.

Ehat's complaint asserted claims under the federal copyright statutes, on which the judge granted summary judgment for the Tanners. In addition, the complaint alleged state common law claims for unfair competition

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1. William Clayton lived during the 1800's and was for a time the private secretary to Joseph Smith, the first president of the LDS Church. The Journals at issue were kept by Clayton from 1842 to 1846 while he and Joseph Smith lived in Nauvoo, Illinois.

and unjust enrichment. Following a bench trial on these claims, the Court entered judgment for Ehat. On appeal, the Tanners assert that the district court erred in awarding damages on Ehat's common law claims because those claims are preempted by the

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2. In this regard, the complaint alleged as follows:

> "The unauthorized and infringing use therefore by the defendants of the copyrighted work, the publication of stolen or 'obtained without permission' notes that were unpublished in which the plaintiff owns the exclusive proprietary interest, and the unfair and illegal use of purloined work product and research intended by plaintiff to be published in his own right will cause, unless enjoined, irreparable harm, damage and injury to plaintiff, will constitute unfair competition and unjust enrichment of the defendants from the work product of the plaintiff and will rob the plaintiff of his proprietary interest in both published and unpublished materials vouchsafed to him by the statutes of the United States noted hereinabove."

Rec. vol. I, at 5.

federal copyright statutes. We agree.

Federal copyright law was amended by the Copyright Act of 1976 to preempt state law as follows:

> "On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of author that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State."

17 U.S.C § 301(a) (1982). Congress expressly stated that section 301 is intended to prevent "the States from protection . . . [a work]

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3. Ehat has not appealed the grant of summary judgment against him on his federal copyright claim.

even if it fails to achieve Federal statutory copyright because it is too minimal or lacking in originality to qualify, or because it has fallen into the public domain." H.R.Rep. No. 1476, 94th Cong., 2d Sess. 131, reprinted in 1976 U.S.Code Cong. & Ad.News 5659, 5747. State law forbidding others to copy an article "unprotected by a patent or a copyright . . . would interfere with the federal policy, found in Art. I, § 8, cl.8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain." Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 237, 84 S.Ct. 779, 782, 11 L.Ed.2d 669 (1964); see also Suid

v. Newsweek Magazine, 503 F.Supp. 146, 148 (D.D.C.1980).

Under section 301, a state common law or statutory claim is preempted if: (1) the work is within the scope of the "subject matter of copyright" as specified in 17 U.S.C. §§ 102, 103; and (2) the rights granted under state law are equivalent to any exclusive rights within the scope of federal copyright as set out in 17 U.S.C. § 106. See Harper & Row Publishers, Inc. v. Nation Enterprises, 723 F.2d 195, 199-200 ;(2d Cir.1983), rev'd on other grounds, _____ U.S. _____, 105 S.Ct. 2218, 85 L.Ed.2d 588 (1985); Schuchart & Associates v. Solo Serve Corp., 540 F.Supp.

928, 942 (W.D.Tex.1982); 1 M. Nimmer, Nimmer on Copyright § 1.01[B], at 1-9 (1985).

[1] Literary works, including compilations and derivative works, are within the subject matter of copyright if they are original works of authorship fixed in any tangible medium of expression. See 17 U.S.C. §§ 102, 103. This is so notwithstanding the material could not be copyrighted. See Harper & Row, 723 F.2d at 200. The material at issue here clearly falls within the subject matter of copyright. The district court did not address this issue, and Ehat does not argue otherwise on appeal.

We now turn to whether the rights Ehat seeks to assert under state common law are

equivalent to those exclusive rights within the scope of copyright. Under federal law, the owner of copyright has the exclusive right "to reproduce the copyrighted work" and "to distribute copies" to the public by sale. See 17 U.S.C. §§ 106(1), (3).

> "When a right defined by state law may be abridged by an act which, in and of itself, would infringe one of the exclusive rights, the state law in question must be deemed preempted. . . . Conversely, when a state law violation is predicated upon an act incorporating elements beyond mere reproduction or the like, the rights involved are not equivalent and preemption will not occur."

Harper & Row, 723 F.2d at 200 (citations omitted).

[2] In an effort to distinguish this case from a preempted claim, the district court greanted Ehat relief based on its finding that, by printing and selling Ehat's notes, the Tanners "bodily appropriated the work product of plaintiff" and derived a profit from their misappropriation. Rec., vol. V. at 13-14. We need not decide whether this misappropriation of material states a claim for relief under Utah law. Assuming that it does, see generally International News Service v. Associated press, 248 U.S. 215, 39 S.Ct. 68, 63 L.Ed. 211 (1918); Prosser and Keeton on Torts § 130 at 1020-22 (5th ed. 1984), we see no distinction between such a state right and those exclusive rights

encompassed by the federal copyright laws. See Warner Bros., Inc. v. American Broadcasting Co's., 720 F.2d 231, 247 (2d Cir.1983)("state law claims that rely on the misappropriation branch of unfair competition are preempted"); Schuchart & Associates, 540 F.Supp. at 943-44 (same). See generally 1 Nimmer § 1.01[B], at 1-16 to 1-22. We cannot agree with the district court that Ehat's state claim was not within the scope of copyright because it was based on his right in the notes "as a physical matter and property." Rec., vol. V, at 9. Ehat did not allege a state law claim of conversion to recover for the physical deprivation of his notes. Instead, he sought to recover for damage

flowing from their reproduction and distribution. See Harper & Row, 723 F.2d at 200-01. Such reproduction interferes with an intangible literary or artistic property right equivalent to copyright. See 1 Nimmer § 1.01[B], at 1-14.4 n. 51.

[3] Our view of the nature of Ehat's claim is confirmed by the district court's award of damages. The court awarded $960, representing the Tanners' profits from the printing and sale of their publication, which is clearly an award for the reproduction of Ehat's work. The court also awarded $3,000 which it found Ehat suffered as a reduction in the market value of his master's thesis due to the misappropriation. This damage also flows

from the reproduction of the material rather than from its physical taking. See Harper & Row, 723 F.2d at 201. Finally, the court awarded Ehat $12,000 for general damage to his reputation as a scholar resulting from "defendant's unlawful and improper publication." Rec., vol. V, at 15. Because the reputation injury arose out of the copying of Ehat's work, that claim is preempted as well. See 1 Nimmer § 1.01[B], at 1.14.2 n. 49.

The judgment entered by the district court conclusively establishes the nature of Ehat's claim as equivalent to one within the scope of the federal copyright. The court thus stated:

"IT IS NOW HEREBY ORDERED, ADJUDGED AND DECREED:

1. That defendants' publication as such of a facsimile of the 'Ehat notes' as referred to in the findings herein was and is unlawful and a violation of plaintiff's rights thereto.

2. That by reason of said publication the plaintiff is hereby granted judgment against the defendants for the sum of $15,960, with interest from date of judgment at the rate provided by law." Rec., vol. I, at 196 (emphasis added).

[4] Ehat "cannot achieve by an unfair competition claim what [he] failed to achieve under [his] copyright claim." See Durham

Industries, Inc. v. Tomy Corp., 630 F.2d 905, 918 (2d Cir.1980).

> "The intention of section 301 is to preempt and abolish any rights under the common law or statutes of a State that are equivalent to copyright and that extend to works coming within the scope of the Federal copyright law. The declaration of this principle in section 301 is intended to be stated in the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation of its unqualified intention that Congress shall act preemptively, and to avoid the development of any vague borderline areas between State and Federal Proection."

H.R.Rep. No. 1476, 94th Cong., 2d Sess. 130, reprinted in 1976 U.S.Code Cong. & Ad News, 5659, 5746.

Accordingly, Ehat's state law claim is preempted. The case is reversed and remanded

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4. Ehat's reliance on Roy Export Co. v. Columbia Broadcasting Sys., 672 F.2d 1095 (2d Cir.1982), is misplaced because that case was decided under the prior copyright law. Roy Export involved film clips protected by federal copyright and a compilation that included the clips which was protected by state common law copyright.

for further proceedings consistent with this opinion.

APPENDIX B

IN THE UNITED STATES DISTRICT COURT

STATE OF UTAH, SALT LAKE CITY

ANDREW F. EHAT,	)	
	)	
PLAINTIFF,	)	Case No. C83-0593C
	)	
VS.	)	
	)	COURT'S RULING
JERALD TANNER, ET. AL.	)	
	)	
DEFENDANT.	)	
	)	

BEFORE THE HONORABLE A. SHERMAN CHRISTENSEN

MARCH 23, 1984

SALT LAKE CITY, UTAH. MARCH 23, 1984, FRIDAY. 2:20 P.M.

THE COURT: Ladies and gentlemen, I apologize for being 20 minutes late. A matter of trying to go over notes, refresh recollection as to records, and formulate ideas, however roughly or time consuming. Yet I'm convinced that when I feel myself adequately advised, and all of us have been studying this case over a period of time, and the result depends at least in part upon recollection as to facts testified to as well as arguments and perceptions of counsel as they contend with each other, one is seldom in a better position to rule upon matters given adequate preparation [than] when those things are fresh in his mind. Accordingly, I propose today to make and enter my findings of fact and conclusions of law. I find as follows:

1. The plaintiff, Andrew F. Ehat, a resident and citizen of the state of Illinois, and the defendant, Jerald Tanner and Sandra Tanner, who have done business under the name of Modern Microfilm Company, are residents and citizens of Salt Lake County, State of Utah. This action involves conduct of the defendants which occurred within Salt Lake County, Utah, and arises under the laws of the United States, involves a pendant state claim on essentially the same facts.

2. Plaintiff is a graduate student of Southern Illinois University, pursuing his studies toward a Ph.D. in History, who by reason of his experience and reputation as a scholar and researcher and writing concerning the history of the Church of Jesus Christ of Latter-Day Saints, called the Mormon church, enjoyed access to original documents and other sources of information within the ownership or care, custody, and control of that church. For more than ten years the defendants have been involved in investigation and research

and in the publication and distribution of scholarly or historical documents and works and commentaries with regard to the history of that church from a somewhat different perspective or viewpoint.

3. William Clayton lived during the 1800's and was for a period of time the private secretary of Joseph Smith, the first president of the Mormon church. William Clayton kept three personal journals or diaries during the time that he and Joseph Smith resided in Nauvoo, Illinois, during the period November 27, 1942, through January 30, 1846 -- if I said 1942, of course I meant 1842 -- through January 30, 1846. These journals I will refer to generally as the Clayton Journals.

4. The ownership, property, or literary rights, copyrights or other interest in the Clayton journals and other similar original documents in the possession of the Mormon church is not an issue in this case, nor is that church a party to this action. It has

been sufficient to determine for the purposes of this case, as I do, that that church has had over a substantial period of time the exclusive and lawful custody and possession of the Clayton journals with unquestioned authority to grant access to them as physical property to whomsoever and under the conditions it may determine. And whatever its rights may be, it is clear that its rights are superior to the rights of any of the parties of -- in it to the original journals, including its right to grant access to those original journals as physical property to whomsoever and under the conditions it might determine.

5. During the approximate months of January and February of 1979 the plaintiff obtained from the Mormon church permissive access to and did in fact read the Clayton journals, particularly three volumes covering the time period 1842 to 1846. The plaintiff took therefrom notes and dates, and later within said time copied from a transcript of

said journals approximately 77 pages of extracts. On his extracts plaintiff added editorial comments of his own and dates, notes of spelling and accuracy, and other minor insertions. In the process the plaintiff expended as a researcher substantial time and effort.

6. Three other historians, Dr. Richard Anderson, Dr. James Allen, and Dr. Dean Jesse, also had access to the Clayton journals during the same period, and Jesse and Allen collaborated in making a complete typescript of said journals, and by a preponderance of the evidence the Court finds that that was with the acquiescence and consent of the Mormon church. It was from said typescript that extracts in plaintiff's possession were taken. Sometime in the fall of 1980 plaintiff received from James Allen an additional approximately 12 pages of extracts from the Clayton journals that constituted reported sermons of Joseph Smith which Clayton had recorded in the original journals. At the

time of receiving these pages from Allen, plaintiff obtained permission from Allen to use them in a book then in process ultimately authored by plaintiff and Lyndon W. Cook entitled The Words of Joseph Smith. Again, the preponderance of the evidence establishes that that furnishing, copying, and use, was with the acquiescence and consent of the Mormon church.

7. In addition to using the Clayton extracts in the book, The Words of Joseph Smith, plaintiff used other extracts in an article printed in the BYU Studies and used other extracts in his master's thesis, Joseph Smith's Introduction of Temple Orinances and the 1844 Mormon Succession Question. Prior to the compiling and printing of all three publications, plaintiff obtained permission specifically from Don Schmidt, LDS Church Archivist to use the extracts in each of the said works.

8. The usage in the profession of historians in the general area when copying or

quoting documents from repositories, public and private, is that access to the document carries with it the implication that the party examining the document may make occasional quotes from it in connection with the research done to examine the same. This does not extend to permitting a total reproduction of said document in print. Further custom in the profession is that if something more than occasional quotes is desired for publication, the historian must obtain express permission either orally or in writing for such extended quotations.

9. The general usage in the profession between historians is that when a document or source of quotation or a quotation is shared, the party, by receiving it, gains no authority to further circulate the document or quotation, and should he intend to allude to it or quote it or publish it in part or in whole, he first obtains the permission of the giver and attributes or cites the giver as his source, or as they may agree cites the

original depository or source from which it was originally obtained by the giver. These customs as disclosed by the evidence are not accepted by the Court as legal requirements, but they are germane in appraising and examining the facts with regard to the custody of copies of the Clayton journal, and the sharing of those copies among historians or researchers. Plaintiff shared a copy of his Clayton extracts which will in the 88 pages comprising them be referred to as the Ehat extracts, with his co-author of the book The Words of Joseph Smith, Lyndon W. Cook, who recognized that that copy was to be used only for his own reserach in collaboration with plaintiff or with his consent, and that he was not to release or distribute copies to anyone. This copy was ultimately stolen from Cook's files, photocopied, and circulated, all without permission or authority of Cook, and all without permission or authority of the plaintiff. The copies stolen consisted of Ehat's 88 pages of the so-called Ehat notes

which had been assembled by Ehat as a result of his access to the original journals and typewritten copy as mentioned in the precise form he determined to be most useful to him and historically significant for his purposes.

10. By reason of plaintiff's reputation as a Mormon scholar, a special privilege he had enjoyed in getting original access to the original Clayton journal and his relationship to other scholars who had similar access pursuant to authority and in keeping with his efforts to compile an accurate copy of the extracts from the Clayton journal which would have maximum historical value for his purposes as a writer and scholar, and be of significance as an original source material which he chose to publish them, the plaintiff acquired and had a special possessory interest in his notes as he had personally prepared them, which was recognized by the limited number of colleagues with which he shared copies, and particularly by Lyndon W. Cook. That special propietary or property interest

in his physical notes did not include any copyrightable interest in their content apart from certain interpretations and comments hereafter to be mentioned.

11. The quotations from the Clayton journals themselves were not a product of any literary effort of accomplishment by plaintiff nor any creativity and were not subject to copyright or any copyright interest in plaintiff's favor, but plaintiff's rights in the Ehat notes as a physical matter and property was of a nature and character different in kind from any copyrightable interest there may have existed in said original writings comprising the Clayton journals, and were and are not within the scope or purpose of of rights established under the copyright laws of the United States or any equivalent.

12. The copy of plaintiff's assembled extracts, plaintiffs comments and interpolations which plaintiff had entrusted to Professor Cook as already described, was in

the early part of 1982 surreptitiously removed from the files of Professor Cook, which he maintained for his own use in his office, by one Kelly Johnson who had gained access to that office under the guise of using it for the purpose of religious gathering exclusively and who, unknown to Dr. Cook and without his authority, searched through Dr. Cook's personal files -- now I could be mistaken in this, buy my recollection is it was within a file cabinet and not laying on his desk, although my recollection is that a previous paper was laying on his desk and which was extracted by Johnson and then returned with an apology without mentioning the extraction from the file itself of the Ehat notes. Thus, it does appear by a great preponderance of the evidence that with the deception and subterfuge that had been mentioned, Johnson went through Dr. Cook's personal files in a file cabinet, and without authority extracted and stole the 88-page copy of the Ehat notes which had been entrusted to him.

After Johnson had removed said notes from Cook's office under such circumstances, he surreptitiously made a photocopy or copies thereof, then secretly, in order to avoid detection, returned the copy he had stolen, the copies so made being exact facsimiles. Our basic concepts don't change very often, but their application changes in connection with the development among other things of modern technology, and I can perceive no difference, although Dr. Cook's precise copy was stolen and thus reproduced, in that situation and a situation where the very physical piece of paper that had been stolen had been stolen without being thereafter copied, in the progress of events was published in the precise form that the original notes in Cook's possession were as they had been stolen.

13. In May or June, 1982, the defendants received an exact copy of the stolen Ehat notes consisting of the 88 pages exactly as plaintiff had recorded them including this

said interpolation and the comments of plaintiff from one Kent Walgren, a Salt Lake attorney. Neither defendant -- neither defendants nor Kent Walgren were involved in the original theft of the Ehat notes. At that time, hwoever, Kent Walgren knew, according to my view of the preponderance if not overwhelming evidence, that the notes he delivered to defendants were a copy of the very notes that had been stolen from Professor Cook's office. Nor can the Court accept the claim or argument that this was in the course of an underground sharing of stolen or misrepresented documents or mispropriated documents for the purpose in and of itself laudable of diffusing knowledge and viewpoints and sharing historical information for profit, advantage, or as a public service, and that this excuse the conduct of the participants or that others may have participated in similar conduct as a reason for disregarding the rights of the plaintiff does not impress the Court in view of the absence of any convincing

proof that the plaintiff was a party to such practice or failed to do anything -- everything within his power to correct or remedy the situation in which he found himself upon discovering that Cook's notes -- Cook's copy of the Ehat notes had been stolen.

13. At the time when the defendants received the copy of the Ehat notes from Walgren, they knew that said notes as so received were an exact photocopy of the Ehat notes which had been stolen from Dr. Cook's office, and they either -- and they not not only confirm but they rather boasted about that knowledge when they published said notes, not only verbatim, with -- after excising comments that they thought might subject them to liability to the plaintiff under the copyright law, but in th eprecise form and arrangement of the stolen notes. Among other things in their signed or in their attributed introduction, I don't know whether they signed it by handwriting, but it was printed, they appeared in print as the authors preceding the

publication of the exact Ehat notes as indiciated, they recited from press reports and comments with the apparent approval and at least implied acceptance the very circumstances of the stealing that have been confirmed more specifically in the evidence.

Among other things in their introduction they claimed no lack of knowledge as to how they came to get the copy or no understanding that it was anything but an exact reproduction of the physical paper that Ehat had prepared and entrusted to Dr. Cook, but they said among other things on this point, quote, "In an article entitled Restricted Church Documents Stolen, the 7th East Press reported the following, the names David Brown and Tom Wilson are pseudonyms, according to this paper," and then they quote the accounts that they read emphasizing throughout that in the first place the material was restricted. "A BYU Graduate student has accused a member of a bishopric of stealing copies of materials which the student obtained from the vault of

the First Presidency. In doing research in the LDS church, Andrew F. Ehat obtained permission to examine restricted Nauvoo diaries of William Clayton and make notes. He gave a copy of his notes to BYU religious instructor Lyndon Cook who kept these in his campus office. The notes were taken without permission and photocopied by David Brown, a member of the bishopric which uses Cooks's office."

Well, the evidence doesn't disclose it was Brown in the first instance, but Johnson, and that's a variance, but that would make no difference as to my concept of the notice with which defendants published the material in question, and then as if to dispel the argument that Ehat was somehow negligent in not attempting to do everything he could to maintain the privacy of his notes, irrespective of this, it goes on to say: "Individuals present report that Ehat was extremely upset." They recite further, "Ehat was able to obtain five copies of the

reproduced notes within 12 hours, but that three of the people who turned in copies had secretly made extra copies." It might occur to one that if these were a rigged proceeding within the view of the defendants, it would hardly be in keeping to have Ehat so disturbed about the matter as indeed the evidence shows clearly that he was.

The so-called Introduction leaves no room to speculate whether the defendants were on notice and had knowledge of the theft, and that the copy they published was a precise -- a precise copy of the very thing that was stolen. This newspaper account they quote was several months before the defendants published the material in question.

14. I further find that in printing plaintiff's extracts, defendant bodily appropriated the work product of plaintiff, and in doing so, sought to and did profit from the efforts of the plaintiff under the circumstances mentioned through the physical misappropriation of his notes.

15. I further find that because of defendant's publication of plaintiff's notes, plaintiff's access to private repositories is impaired to a degree. His future use of the remaining extracts in his doctoral dissertation is imparied for which -- and the negotiations and saleability of the dissertation are impaired, and that plaintiff has been put to considerable expense in attempting to vindicate his rights in this case. I further find with regard to plaintiff's claim for damages that the proof is quite unsatisfactory in many respects and in some respects is insufficient, even in view of the rule that when one by an improper act deprives an opposing party of the ability to reconstruct, which would have happened without the infraction, the Court is very liberal in accepting estimates with some substantial foundation in the record. Thus, plaintiff's claim for expenses in connection with his efforts to protect his property rights and his notes in the amount of $2,400 must be

rejected. That particular item on the ground that that isn't recoverable as proximately caused damages under the accepted rule. I do find the evidence supports damages for $960 against the defendants representing defendant's profits in the printing and sale of approximately 1,950 copies of defendant's publication. That plaintiff further as a proximate cause of defendant's improper publication has suffered damage in the amount of $3,000 in reduction of the potential market value of his master's thesis, dependent substantially upon his use therein of the Ehat notes unanticipated by a misappropriator of his propietary interests therein.

I further find as general damages to plaintiff's [reputation] as a scholar and research historian plaintiff -- and as a proximate result of defendant's unlawful and improper publication, the plaintiff has suffered damages in the sum of $12,000.

17. I find that the conduct of the defendants was deliberate, and in bad faith in

some respects. In view of the co-mingling of ideas and claims concerning freedom of speech, freedom of press, however irrelevent to the peculiar circumstances of this case they may have been, but asserted in good faith by the defendants, and because of the Court's commitment to these principles which might be compromised or misunderstood were punitive damages to be awarded, and because the issue of punitive damages was reserved by plaintiffs neither in his complaint nor in the pretrial order which I made clear governed the proceedings at the trial, and no amendment to either having been requested, punitive damages within the discretion of the Court will be denied.

18. The Court finds that unless an order is issued enjoining the defendants from continuing to publish and/or sell or circulate the Ehat extracts as such is or as they are printed in the Tanner publication, Clayton['s] Secret Writings Uncovered, received in evidence in this case, the defendants will

continue to do so to the irreparable damage of the plaintiff, and the defendants in so doing would be unjustly enriched, and thus I find it reasonably necessary and appropriate to enjoin the defendants, their agents, and employees, and those acting under their direction or in concert therewith from publishing said Ehat extracts in form as thus appropriated. I have no disposition nor intent in any way to impede the dissemination of the knowledge or the ideas, but the very thing that has been thus misappropriated cannot lawfully be continued to be sold and distributed by the defendant and those acting under them.

19. In view of the fact that the primary efforts of the defendants in defense of this action, irrespective of the particular grounds of complaint, has been to establish their right of publication of the Ehat notes as such and as misappropriated and converted by them knowingly, and in view of all of the other circumstances of the case, the Court denies an award of attorney's fees and in view of the

fact that -- attorneys' fees to either party, and in view of the fact that with regard to the particular claims made by the plaintiff, plaintiff has succeeded in part and failed in part as the defendants have succeeded in part and failed in part, an award of even taxable [costs] will be denied.

From these finding of fact the Court now draws the following conclusions of law.

1. The Court has jurisdiction over this action and jurisdiction to award the relief hereby granted because that action involves a state claim to the extent recognized here which is pendent to a federal claim arising under the laws of the United States, and by reason of the diversity of the citizenship between the parties, and that venue in this district is proper. The original pleadings have co-mingled the claim for copyright infringement and unfair competition, and there was no objection to that co-mingling on the part of the defendants in formulating the issues, the pretrial order reserves the issue

of unfair competition and I think implicit in the matter before me with regard to the pendent claim or whatever legal theories may support this action. Accordingly the Court, if there should have been any problem of pleadings that could have been amended in advance and was not, will deem the complaint amended to conform with the claim hereby recognized and the proof which I deem justifies it.

2. That the plaintiff has no copyrightable interest in the so-called Ehat notes nor their ideas nor content, and that plaintiff's claim against the defendants for copyright infringement should be dismissed with prejudice.

3. That the plaintiff's pendent claim for unfair competition and unjust enrichment through conduct in the nature of violation of a trade secret or partaking of principles related thereto as dealt with in the case of Kewanee Oil Company versus Bicron Corporation, 416 U.S. 471, and based specifically upon the

theft and misappropriation bodily of the Ehat notes in which plaintiff had a valuable proprietary and possessory interest and which defendants in effect for profit physically misappropriated, is essentially different in kind and character from any rights within the scope of protection of the copyright act or any equivalent right or remedy and is not pre-empted by the Federal Copyright Act nor any authority of decision pusuant thereto.

4. That the ownership, property right, or copyright interest in the historical documents in the possession of the LDS church are not in issue in this case nor is the church a party to this action. And that for the purposes of this case it is sufficient to determine that it had and has a lawful and exclusive custody and control fo the original writings involved here with authority to grant access to them during relevant times to whomever and under what conditions it might choose.

5. That apart from the ideas expressed therein, the Ehat notes as they were physically made and recorded by the plaintiff and mispropriated and published by the defendants represented a valuable proprietary interest in the right of the plaintiff, the violation of which the plaintiff has a valid claim against the defendants which has been established in this case.

6. The Court concludes that this is not a case involving conflicting issues of religious liberty, the right of expression of conflicting or critical ideas, freedom of the press, freedom of speech, prior restraint, or the free interchange of ideas, it is simply one involving the protection of property interests in the Court's view against theft and the knowing exploitation thereof for commercial gain in unfair competition with those possessing the possessory proprietary interest.

It isn't an easy case. There are conceptual, statutory, and precedential

difficulties presented in defendants claim, and there are principles strongly supporting it. One can note this in various cases, for example, in International News Service versus Associated Press, 248 U.S. 215 (1918); Kewanee Oil Company versus Bicron Corporation, which I have already mentioned; Schuchart and Associates, Professional Engineers Incorporated, --I'm sorry, Schuchart and Associates, Professional Engineers Incorporated vs. Solo Serve Corporation, 540 F.Supp. 928, Western District of Texas, 1982, citations to which I gave counsel yesterday, which I think is a case perhaps most strongly supporting defendant's contention of pre-emption and written by one whom I know personally to be an excellent judge. New York Times Company versus United States, 403 U.S. 713 (1971), entirely different issue of restraint, but in the concurring and dissenting opinions of which may be found words of wisdom which could touch if not affect our problem. Harper and Row Publishers

versus Nation Enterprises, 501 F.Supp. 848, Southern District of New York, 1980, Grove Press Incorporated vs. Collectors Publication Incorporated, 264 F.Supp. 603, Central District of California, 1967; Capital Records Incorporated vs. Richard W. Erickson, 2 Cal.App.3d 526, 40 ALR3d 553, certiorari denied 398 U.S. 960 (1969); [Roy] Export Company vs. Columbia, 503 F.Supp. 1137, Southern District of New York, 1980, affirmed 672 F.2d 1095, certiorari denied, 646 Law.Ed. 2d 63, 1982. E.I. duPont deNemours and Company vs. Christopher, 531 F.2d 1012, 5th Circuit, 1970, among others.

I have merely cited these so that counsel will know what has had influence upon my mind because a number of those haven't been mentioned by counsel and a number have. But despite the [shoals], so to speak, the importance of the issue here in the Court's view transcends the somewhat limited pecuniary interest of the parties and certainly any difficulty of bother to the Court in

perceiving and applying correct principles with appropriate differentiation of essentially different situations. It is clear that the Ehat notes were not copyrightable as I have indicated, nor is recovery permitted under any equivalent theory in view of the 1976 amendment to the Federal statute pre-empting the field of copyright and indeed of the view of principles that had been expressed anticipating such statutory provisions. Certainly the idea that public research materials can be reserved for historians only for the purpose of dissemination by those who share their own religious, philosophical, or intellectual viewpoints is repugnant to me, and it is to the First Amendment and Fourteenth Amendment of the Constitution of the United States. And the very essence of scholarly pursuit mandates that the acquisition [or] discernment of knowledge shall not be constrained by any considerations not compelling and essential to sustain the

American system best calculated overall to achieve expanding freedoms.

I certainly agree with the language of Mr. Justice Brandeis, although not pausing to inquire into the context in which he applied it, that the noblest of human production, knowledge, truth ascertained, conceptions, and ideas become, after voluntary communication to others, free as the air to common use. That expression is both grand and an important principle. And yet we must inquire deeper in cases coming before courts than generalizations that often people indulge in in applying concepts to inappropriate situations. And I have inquired of myself whether it must be held that our legal system has painted itself and its citizens into a corner where private archives can no longer honestly acquire, process, study, and publish manuscripts which have not already entered the public domain and exercise over them a proprietary right or permit others to do so in private under limited permission until within

that permission they are made a part of the public domain.

But must it be held that where as such documenns as studied and analyzed in private they can be physically stolen or equivalently misappropriated and then through this means added to the public domain by peddling them for profit to whomsoever the thief or receiv[er of] the documents with knowledge of the theft may wish, and that thereby the recipients can enrich themselves or accomplish their pecuniary or nonpecuniary purposes, and that the exchange of historical documents must be underground, and that the law must recognize that underground distribution of stolen documents is the -- an accepted way of life beyond protection, and particularly in the context of this case that when that surfaces the law will protect the public exploitation of stolen documents as such, independent of the ideas which they may portray. If this were so, we would have established a system designed to destroy the

very foundations of scholarly research and the preservation of historical writings and the relevant widening public knowledge of history, and every depository from the east coast to the west coast would have to revise its basic principles and be victims without legal remedy to anyone who directly or indirectly steals their physical property, and with knowledge or with knowledge of theft publishes it contrary to their claimed rights and against their will.

I do not think under the authorities that I have read that the courts have been so painted into a corner of futility and self-defeat of this nature, and if that were so, it would be a step immeasurably back from the spread of knowledge that has occurred within the protection of our constitution and estasblished authority, and particularly with regard to writings. If it were to be held that no property in the physical writing could be protected in a court of law even though that physical writing were stolen unless it

were subject to copyright or a right equivalent thereto, not including theft, it would be an unfurtunate thing. On the contrary, however, I believe that some of the strongest and most respected pillars of the common law [and] equity and the state rule which I think will be recognized and is recognized in Utah in principle mandate to the contrary, among these are nemo dare potest quod non habet, no man can give what he hasn't got. Thou shalt not steal. He who receives stolen property acts improperly in the same kind although not in the same degree necessarily as the thief. One may not profit by his own wrong.

There is a valid distinction in the degree and nature of its protection betwen physical property lawfully in one's possession and the possession of ideas not subject to copyright which, except for the narrow limitations I suggested in the words of Mr. Justice Brandeis are free as the air, should be. To recognize these principles is not to

impede public knowledge but to sustain the very foundations on which the dissemination of knowledge and other essential operations of an ordered society of freedom must represent in my judgmnet.

6. The plaintiff's entitled to a judgment for compensatory damages against the defendant in the sum of $960 representing profits made by the defendants for the unlawful publication of the Ehat notes, for the sum of $3,000 for the reduction by defendants unlawful acts of the potential market value of the publication of plaintiff's master's thesis, for the sum of $12,000 for damage to plaintiff's reputation as a scholar and researcher; that while other claims for damage the Court regards as so speculative or uncertain as to preclude award, it is considered that the awards actually made are fully supported by a preponderance of the evidence. In view of the circumstances of the case, I have considered whether the award of $960 of profits, which the evidence shows

inured to the defendants, was duplicative of the other awards. My judgment tells me that the total amount of damages is substantially in excess of what I have awarded, even by the aggregation, and it so happens that the precise measure of profits is the only exact figure we have, and I am convinced that damage, if we don't -- if we consider an equivalent in the same light as the injury plaintiff has suffered as distinguished from the benefit, pecuniary benefit defendants have achieved, there would be an equivalence from that different view point under the preponderance of the evidence substantially in excess of the $960 item anyway.

7. That in view of the circumstances of this case, and in the exercise of its discretion, the Court has denied an award of punitive damages against the defendants, denied the defendants the recovery of attorney's fees in expenses against the plaintiff.

8. That in view of the fact that each of the parties succeeded in part and failed in part on the claims asserted in the complaint, no taxable costs shall be awarded.

These findings of fact and conclusions of law are intended to be and are deemed to be in compliance with Rule 52(a) of the Federal Rules of Civil Procedure as they are stated in open court on the record.

Counsel for the parties are hereby directed to submit to the Court jointly or severally, as they may elect, an appropriate form of judgment in harmony with these findings of fact and conclusions of law within a period of ten days together with any suggestions or motions in anticipatory complaince with Rule 52(b), Federal Rules of Civil Procedure. The Court thereupon without further argument, unless otherwise determined by it, but with reservations of its privilege to file a memorandum of law in further support of its conclusions herein expressed are as

they may be modified will execute and enter judgment.

Any suggestions or motions for the amendment of the Court's findings and conclusions within the period of ten days I have allowed for the submission of proposed judgment form will not be deemed a waiver of the right of the parties to file such motion to amend following the entry of judgment as provided in Rule 52(b), and any submission after proposed judgment in conformity with the Court's finding of fact and conclusion of law will be deemed by the Court to be simply as a convenience to the Court in reflecting the views of the parties as to the form of judgment only in the event the court's findings and conclusions are sustained, and not as any waiver or weakening of the contentions of the respective parties as heretofore expressed or as may hereafter be advanced. In other words, I am seeking your help as an officer of the court to better enable me to properly reflect my determination

in a judgment in a proper form which will in no sense be interpreted as a waiver of any contention that you have made or which you will make.

Is there anything further to come before the Court at this time?

MR. BARNARD: Your honor, implicit in the Court's ruling is a complete denial of my motion in limine. I would simply like to clarify that and make sure that that is the Court's ruling that my motion in limine was denied in total.

THE COURT: Yes.

MR. BARNARD: Thank you.

THE COURT: In view of the record and in view of my ruling pro forma to see if there could be any possible prejudice and in view of any showing at all that there was prejudice, the ruling will be final subject to any further showing. Anything further?

MR. MADSEN: If the Court would rather have us do this subsequently, I don't believe

the Court in its conclusions made reference to injunctive relief.

THE COURT: To what?

MR. MADSEN: To injunctive relief, the restraining order.

THE COURT: I'm sorry I should include and order the conclusion that the Court should in efffect enter judgment enjoining and restraining the defendants and all those acting for or in concert with them or under their control from publishing hereafter or herafter distributing or circulating or selling or marketing the Ehat notes in the form I have held they were physically appropriated by the publication of the defendant's in evidence or in any otherpublication. There has been some discussion as to whether the defendants have transferred any interest or control in a publication for future purposes. I think that has no significasnce with regard to the award of damages because damages awarded simply relate to the damages which I find by a

preponderance of the evidence were caused by the defendants. For the purposes of damage, however, I considered that the transfer made no substantial difference because of general knowledge of its principle officers, the transfer was made subject to that knowledge and with the same sort of notice.

I may say for the information of counsel, I am not ruling now upon the question of the complete insulation of liability of the successor non-profit corporation for contempt. I must say that it could well be under the present evidence that the successor corporation is under the effectual control of the defendants as alter-ego or otherwise. It may well be that they are acting in concert with, with knowledge of the defendants, and with knowledge of the defendants in any future exploitation of the Ehat property right as I have found it. I find it unnecessary to get involved in that now because if there is a continued publication and distribution by anyone else, the question will come about, is

he or it, someone, who is acting with the knowledge of the defendants and under their control or in concert with them, and in any contempt proceeding that may well be the issue. I find it sufficient to reserve that issue until, if at all, it ever arises. Does that clarify the matter?

Anything further?

MR. TANNER: Your Honor, I --

THE COURT: Talk to your counsel, Mr. Tanner, and I am sure he'll reflect your view to me if it should be --

MR. TANNER: Could I ask a question?

MR. BARNARD: It's been resolved, your Honor.

THE COURT: Have you advised him that he heard the restraining order and I am not going to rule upon that now, but it has been held in the past that having knowledge of an order based upon the record there could be some question, I ask you to advise me to that. I'm not going to rule upon it at this time. Anything further?

MR. MADSEN: No, your Honor.

THE COURT: I think it would be unfortunate and complicating if the defendants would rush around and try to dispose of their copies before the Court could go through this process of entering a sound form and affording defendant's counsel an opportunity to be heard on that before an order is precipitously entered which would be effective. I think I shall say nothing further about that matter unless counsel have further inquiry.

We'll stand in adjournment.

(Whereupon the proceedings adjourned at 3:50 p.m.)

Supreme Court, U.S.
FILED
JUL 21 1986
JOSEPH F. SPANIOL, JR.
CLERK

No. 85 - 1970

IN THE SUPREME COURT
OF THE UNITED STATES OF AMERICA
OCTOBER TERM, 1985

ANDREW E. EHAT,

PETITIONER,
vs.

JERALD TANNER and SANDRA TANNER
f@a MODERN MICROFILM COMPANY,

RESPONDENTS

ON PETITION FOR WRIT OF CERTIORARI
TO THE
UNITED STATES COURT OF APPEALS
FOR THE TENTH CIRCUIT

BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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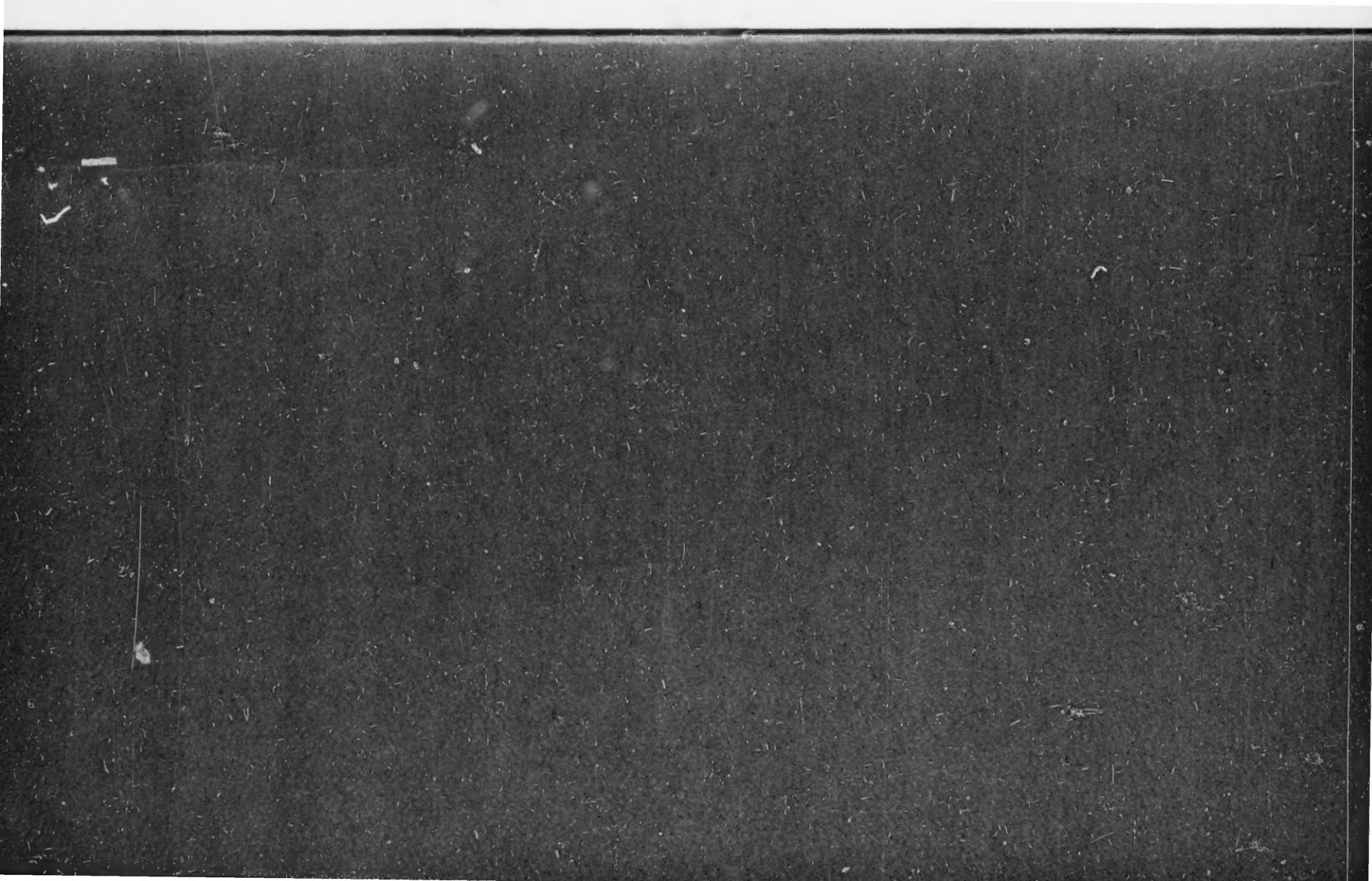
DATED: JULY 21, 1986



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COUNSEL FOR RESPONDENTS

DATED: JULY 21, 1986

ISSUE PRESENTED:

THE COURT BELOW CORRECTLY RULED THAT:

THE FEDERAL COPYRIGHT ACT OF 1976 (17 U.S.C. §301) PREEMPTED THE STATE COMMON LAW CLAIM FOR UNFAIR COMPETITION OCCASIONED BY THE RESPONDENTS' REPRODUCTION AND DISTRIBUTION OF VERBATIM NOTES FROM A HISTORICAL DOCUMENT.

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IN THE SUPREME COURT

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fdba MODERN MICROFILM COMPANY,

RESPONDENTS

BRIEF OF RESPONDENTS IN OPPOSITION
TO PETITION FOR WRIT OF CERTIORARI

RESPONDENTS, JERALD TANNER and SANDRA TANNER by and through their counsel, BRIAN M. BARNARD of UTAH LEGAL CLINIC submit the following BRIEF in opposition to the Petition for a Writ of Certiorari filed by Andrew E. Ehat.

STATEMENT OF CASE

The United States District Court for the District of Utah before trial granted a partial Summary Judgment dismissing Petitioner's copyright claim. After a trial to the bench on the state common law claim of unfair competition, the Court entered a judgment for Petitioner.

Respondents appealed and the United States Court of Appeals for the Tenth Circuit reversed finding that the Petitioner's state common law claim of unfair competition was preempted by 17 U.S.C. §301, the Federal Copyright Act of 1976.

The mandate has issued; the matter was remanded to the Trial Court. On May 20, 1986 the Trial Court entered an Order dismissing the Petitioner's state claim.

STATEMENT OF FACTS

Wm Clayton lived in the 1800's and kept journals or a diary during the years 1842-1846. Wm Clayton was the author of that diary. That diary was a literary work of authorship fixed in a tangible medium of expression and within the scope and subject matter of copyright.

In 1979 Petitioner Andrew Ehat gained access to the original diary and a verbatim typescript thereof. He took seventy (70) pages of verbatim notes from the diary and/or the typescript. Those notes were exact copies of portions of the work created by Wm Clayton. Petitioner Ehat was not the author of those notes; he copied from the original and created an edited version. Neither the

original diary nor Petitioner's notes were copyrighted.

In 1982 Respondents gained access to a copy of the Petitioner's verbatim notes, reproduced them and distributed copies.

Petitioner sued Respondents seeking damages for the reproduction and distribution of those notes under a state claim of "unfair competition;" the Trial Court granted the damages sought; the Court of Appeals for the Tenth Circuit reversed determining that the state common law claim of "unfair competition" was preempted by the Copyright Act of 1976.

REASONS FOR DENYING THE PETITION

POINT I

THE DECISION BELOW IS CONSISTENT WITH THE RULINGS OF THIS COURT.

The decision below is not in conflict with any decision of this Court. The Court Below relied upon the decision in Harper & Row, etc v. Nation Enterprise, etc, 723 F.2d 195 (2nd Cir. 1985); that decision was reversed by this Court on other grounds, __ U.S. __, 85 L.Ed.2d 588, 105 S.Ct. __, 53 U.S.L.W. 4562 (1985). The Decision Below is fully consistent with the decision of this Court in Harper & Row. The two decisions are difficult to compare; one case is about "apples" and the other about

"bananas." Harper & Row involved copyrighted materials admittedly re-printed in violation of the copyright; that use would be protected only if it was found to be "fair use." In the case at bar, the material was not copyrighted and "fair use" doctrine was not involved; the issue here is preemption by federal copyright law of a state unfair competition claim.

This Court in Harper & Row held that the copyrighted material was protected against a gross abuse of "fair use" which destroyed an author's right to first publication. The important right of first publication belongs to the author and/or copyright holder. Harper & Row, __ U.S. __, 53 U.S.L.W. at 4566. The author of the Clayton diary (the historical document at issue here) was Wm Clayton, long

since deceased. As a mere copyist, Petitioner had no right of first publication; that right belongs to Wm Clayton. The right of publication (including "first" publication) is protected by the Copyright Act of 1976; therefore, any state law tort claim that seeks to protect that right is preempted. 17 U.S.C. §301. (See discussion below.)

At the trial and appellate levels Harper & Row involved preemption, and those decisions are consistent with the Decision Below in this case. Harper & Row etc v. Nation Enterprise, etc, 723 F.2d 195 (2nd 1985); Harper & Row, etc v. Nation Enterprise, etc, 557 F. Supp. 1067 (S.D.N.Y. 1983); Harper & Row v. Nation Enterprise, etc, 501 F. Supp. 848, 852 (S.D.N.Y. 1980). (See discussion below.)

Therefore, as far as they are comparable, the Decision Below and Harper & Row are consistent. Both cases involve fruits of creative labor within the scope and subject matter of copyright, one protected by the Federal Copyright Act and one not protected.

POINT II

THE RATIONALE OF HARPER & ROW IS INAPPOSITE TO THE CASE AT BAR.

Petitioner erroneously suggests that Harper & Row somehow repeals the preemption provision of the Federal Copyright Act of 1976. Petitioner suggests that the rational of Harper & Row should expand copyright like protection to non-copyrighted materials. Neither suggestion is well-taken. There is no secret meaning in Harper & Row that circumvents the clear

preemption of the Federal Copyright Act of 1976.

The decision and rationale of this Court in Harper & Row is inapposite to the issues confronted in this case.

POINT III

THE COURT BELOW CORRECTLY FOUND PREEMPTION OF PETITIONER'S STATE TORT CLAIM.

The determination by the Court Below that the Petitioner's state common law tort claim for "unfair competition" was preempted under the Federal Copyright Act of 1976 was proper.

The diary of Wm Clayton falls within the type of materials normally copyrighted; it was a literary work of authorship fixed in a tangible medium of expression and within the subject

matter of copyright. 17 U.S.C. §301(a). The work and notes are so obviously within the subject matter of copyright, no discussion is necessary. (Contra, Petitioner's Brief, pp. 6-8)

Petitioner's verbatim notes are a a reproduction of a work within the subject matter of copyright. 17 U.S.C. §301. They are not copyrightable as to Petitioner because he is not the author. 17 U.S.C. §102(a). (Petitioner's Brief, Appendix, p. A-8).

The Court Below determined that the state common law tort of "unfair competition" was preempted by the Federal Copyright Act; that is consistent with the decision of the Court of Appeals for the Second Circuit in Harper & Row, 723 F.2d 195 (2nd Cir. 1985).

The Decision Below cites Harper & Row below with the "signal" See. The signal "See" is used to indicate a dictum which supports the proposition. As cited in the Decision Below Harper & Row at the appellate level is persuasive dictum regarding 17 U.S.C. §301 and preemption. The decision of the Court of Appeals for the Second Circuit was reversed on other grounds because the only issue considered by this Court was "fair use" of a copyrighted work. The state claims, discussed at the Court of Appeals level and found to be preempted (Harper & Row, 723 F.2d at 199-201), were not mentioned by this Court.

The Federal Copyright Act of 1976 severely limited and preempted most state common law claims of unfair competition. It did not keep the

status quo as the Petitioner alleges in his Brief. (Petitioner's Brief, p. 21) After the enactment of 17 U.S.C. §301 state regulation of unfair competition was greatly limited.

Some types of expression though not copyrightable are still protected by the state common law tort claims but only when those types of expression are not within the subject matter of copyright and the right sought to be protected is not the equivalent of the exclusive rights protected by the Federal Copyright Act. (Petitioner's Brief, pp. 20-21)

Preemption was not to extend to causes of action or subject matter outside the scope of the new statute consistent with the United States Supreme Court decisions in Sears Roebuck v. Stiffel Co., 376 U.S. 225,

84 S.Ct. 784, 11 L.Ed.2d 661 (1964) and Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 84 S.Ct. 779, 11 L.Ed.2d 669 (1964). Thus, the new law was not intended to preempt all causes of action for "unfair competition".

> "Misappropriation" is not necessarily synonymous with copyright infringement, and thus a cause of action labeled as misappropriation is not preempted if it is [in] fact based neither on a right within the general scope of copyright as specified in Section 106. . . nor on a right equivalent thereto.

U.S. Code Cong. & Admin. News, 1976, 5748; H.R. Rep. No. 94-1476, 94th Cong., 2d Sess.

An example where preemption would not apply to a misappropriation cause of action is International News Service v. Associated Press, 248 U.S. 215, 39 S.Ct. 68, 63 L.Ed. 211 (1918); "facts" or "hot news" are not within the subject matter of copyright because

there is no author and they are within the public domain, therefore a cause of action for misappropriation of a wire service's "facts" or "hot news" would not be preempted. This is not the case at bar, the subject matter (the authorship and literary work of Wm Clayton) is clearly within the subject matter of copyright.

There is a two part test to determine preemption under 17 U.S.C. §301. The first Section 301 test: Does the subject matter of the Petitioner's claim, verbatim notes from an historical document, fall within the subject matter of the copyright laws? 17 U.S.C. §301(b)(1). Copyright protection is granted to "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. §102(a)(1) & (5). The Wm

Clayton diary clearly falls into that category as do Petitioner's notes. (Petitioner's Brief, Appendix, P. A-8)

The second Section 301 test: Are the rights sought to be enforced under state law "equivalent to any of the exclusive rights within the general scope of copyright as specified by Section 106"? 17 U.S.C. §301(b)(3). Section 106 provides that an author has exclusive rights to reproduce the copyrighted work and to distribute copies. 17 U.S.C. §106.

> In assessing whether a cause of action under state law is "equivalent" to a claim of copyright infringement, the Court must compare the rights sought to be protected under the federal and state laws. . . . The state cause of action must protect rights under the facts of a particular case which are qualitatively different from the rights of reproduction, performance, distribution, or display.

Harper & Row Publishers, Inc. v. Nation Enterprises, 501 F. Supp. 848,

852 (S.D.N.Y. 1980)(trial court decision)

To establish a copyright violation the Petitioner must prove that the Respondents copied and distributed his notes; to establish the Petitioner's claim for unfair competition, the Petitioner must prove that the Respondents copied and distributed his notes. The proof is the same under both causes of action. (Petitioner's Brief, Appendix, pp. A-11-A-12).

The complaint herein demanded an injunction against further distribution of the notes, and sought destruction of the copies in the Respondents' possession: that is the exact relief available under the Copyright Act. (17 U.S.C. §503) The Trial Court initially granted injunctive relief. (Petitioner's Brief, Appendix, pp. 21-22; pp. 39-40)

Petitioner demanded and was granted damages similar to the damages under the Copyright Act. 17 U.S.C. §504(b); Petitioner's Brief, Appendix, p. 34; Petitioner's Brief, Appendix, p. A-12-A-13.

Petitioner made it clear Respondents' conduct which caused him to bring this action was their publication of his verbatim notes, not their misappropriation. (Petitioner's Brief, Appendix, p. A-4; p. A-11).

The use of the "misappropriated" material is determinative of whether or not an unfair competition claim is preempted by the Federal Copyright Act. Misappropriation of another's work is separate from the use thereof, but where an unfair competition claim is related to the use of misappropriated material, the action will be

subject to preemption by federal copyright law. Roy Export Co. Establishment v. Columbia Broadcasting System, Inc., 672 F.2d 1095, 1105-1106 (2nd Cir. 1982). In Warner Bros. v. American Broadcasting Company, 720 F.2d 231 (2nd Cir. 1983) there was a claim for a copyright violation and unfair competition. The offending acts occurred after the effective date of the 1976 Copyright Act. The Court stated:

> Since the Copyright Act is exclusive, after January 1, 1978, only with respect to rights "equivalent to any of the exclusive rights within the general scope of copyright," 17 U.S.C. § 301(a) (Supp. V 1981), state law claims that rely on the misappropriation branch of unfair competition are preempted, . . ." [citations omitted]

Warner Brothers, 247.

The relief Petitioner sought and was granted falls squarely under Section 106 of the Copyright Act of 1976, and satisfies the second test of Section 301. (Petitioner's Brief, Appendix, pp. A-12-A-14).

Examining what the Petitioner plead and proved and examining what he sought and was granted, his rights under the unfair competition claim are the equivalent to the rights under Section 106 of the Copyright Act: the exclusive rights of copyright to reproduce and distribute his work. Petitioner's Brief, Appendix, pp. A-8-A-15; Harper & Row, etc v. Nation Enterprise, etc, 723 F.2d 195 (2nd Cir. 1985), reversed on other grounds, __ U.S. __, 85 L.Ed.2d 588, 105 S.Ct. __, 53 U.S.L.W. 4562 (1985); Harper & Row Publishers, Inc. v. Nation

Enterprise, 557 F. Supp. 1067 (S.D. N.Y. 1983); Harper & Row Publishers, Inc. v. Nation Enterprise, 501 F. Supp. 848, 852 (S.D.N.Y. 1980); Schuchart & Assoc. v. Solo Serve, 540 F. Supp. 928, (W.D. Tex. 1982); Mitchell v. Penton/ Industrial Pub. Co., 486 F. Supp. 22, 205 USPQ 242, (N.D. Ohio 1979); Ortho-O-Vision, Inc. v. Home Box Office, Inc., 474 F. Supp. 672, 205 USPQ 644 (S.D. N.Y. 1979); Synercom Technology, Inc. v. University Computing Co., 474 F. Supp. 37 (N.D. Tex. 1979). Petitioner's state law claim based upon the "misappropriation" branch of unfair competition is preempted by federal copyright law.

CONCLUSION

The Court of Appeals properly interpreted and applied the Federal Copyright Act of 1976 with regard to preemption of a state common law claim "equivalent to any of the exclusive rights within the general scope of copyright . . . in works of authorship that are fixed in a tangible medium of expression. . ." 17 U.S.C. §301(a).

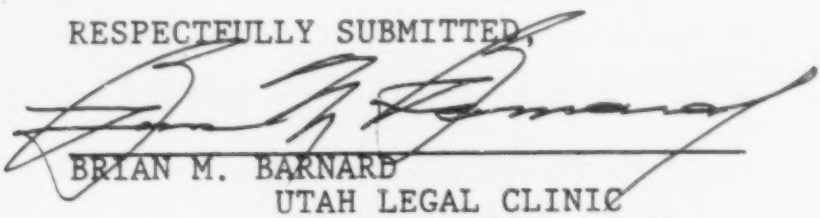
The Petitioner's state common law claim for "unfair competition" involved materials within the subject matter of copyright and the exclusive rights and protections afforded under federal copyright law and therefore was preempted. Given the nature of the Petitioner's work, if it could not be protected by the Federal Copyright Act, it could not be protected from

publication and distribution by a state common law tort claim. Thus the decision of the Court of Appeals for the Tenth Circuit was proper in all respects.

There is no conflict between the Decision Below and any decision of this Court; there is no conflict between the Decision Below and the decision of any Court of Appeals.

For the reasons stated herein, the Respondents request this Court to deny the Petition for a Writ of Certiorari.

RESPECTFULLY SUBMITTED,



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Attorney for Respondents
DATED: July 21, 1986

DELIVERY CERTIFICATE

I hereby certify that on the 21st day of JULY, 1986, I caused to be hand delivered three (3) copies of the above and foregoing BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI to:

GORDON MADSEN, Esq.
ROBERT CUMMINGS, Esq.
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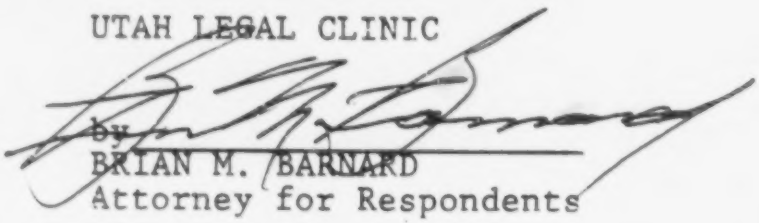

by
BRIAN M. BARNARD
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